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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,615	08/18/2000	Mitsuzou Nogami	000774	7364

7590 08/08/2003

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EXAMINER

MERCADO, JULIAN A

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 08/08/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/622,615	NOGAMI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Julian Mercado	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 May 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11, 19-24 and 26 is/are pending in the application.

4a) Of the above claim(s) 6-10 and 19-24 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5,11 and 26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2003 has been entered.

***Remarks***

Claims 12-18 and 25 have been canceled. Claims 1-5, 11 and 26 are pending. The rejection of claims 1-5, 11 and 26 under 35 U.S.C. 103(a) based on Ohta et al. '726 and Ovshinsky et al. has been withdrawn. Ovshinsky et al. '726 teaches the coating layer as formed around the active material particle (col. 4 line 29-31). Coating of a particle would result in some parts of the coating to be embedded within the substrate, thus, a coating layer formed only on a surface of the active material that comes into contact with the electrolyte solution is not taught or suggested.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 11 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1 and 2 have been amended to recite that the coating layer “is formed only on a surface that contacts with an electrolyte solution of the active material”. This embodiment, as pointed out by applicant, is illustrated in Figure 1. The examiner has reviewed the specification for support of the present amendment, however the specification is not found to enable one skilled in the art to make and use the presently claimed invention. The claims recite that the coating layer [3] is formed on the active material [2], but only to the extent that the surface of active material [2] “that contacts with an electrolyte solution” is coated. In reference to Figure 1, while it appears to the examiner that the coating layer [3] only coats the outermost layer of the active material [2], once this electrode is employed within a battery it is the examiner’s position that the active material [2] would not be in contact with the electrolyte solution due to the coating layer [3] overlaying the surface of active material [2] that would otherwise be exposed to the electrolyte.

It appears to the examiner that the present claims would only be enabled if active material [2] was coated by coating layer [3] *in situ*, thereby enabling the claimed coating of the active material [2] that is resultantly exposed to the electrolyte. This does not appear to be the case in the present disclosure. Page 16 of the specification, line 3 et seq. discloses that the sintered nickel electrode with active material is coated by the coating layer [3], and by this method “the nickel electrodes for alkaline storage batteries [are] thus produced”. It appears to the examiner

that the sintered nickel electrode with active material is an intermediate product, thus, no part of the surface of the active material [2], once coated with coating layer [3], would ever come in contact with the electrolyte solution.

***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record and to the examiner's knowledge do not teach or render obvious at least to the skilled artisan the disclosed invention regarding the instant coating layer [3] coating an active material *layer* [2], as shown in Figure 1. [emphasis added]

The examiner notes that the embodiment shown in Figure 1 is limited to mutually distinct, conformally coating layers and not "partially broken" layers as disclosed on page 16, last line thereof et seq.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayashi et al. (U.S. Pat. 6,027,834) teaches agglomeration coating of a nickel hydroxide active material with yttrium hydroxide, *inter alia*. (col. 3 line 34-47, col. 5 line 20-24). Use thereof in sintered nickel bodies or substrates is also suggested. (col. 11 line 1-7)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (703) 305-0511. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
jam  
August 4, 2003

  
Patrick Ryan  
Supervisory Patent Examiner  
Technology Center 1700